Hovsepian v. Apple, Inc. Doc. 283

COUNSEL LISTED ON SIGNATURE PAGES

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re: ACACIA MEDIA TECHNOLOGIES CORPORATION PATENT LITIGATION	Case No. C 05-01114 MDL No. 1665 **STIPULATED COVENANT NOT TO SUE; ORDER THEREON**

COVENANT NOT TO SUE

1. This Covenant Not to Sue is entered into by Acacia Media Technologies Corporation ("Acacia"), on the one hand, and the following entities, individually or in any combination thereof, on the other: Comcast Cable Communications LLC; Insight Communications, Inc.; The DirecTV Group, Inc.; Coxcom, Inc.; Hospitality Network, Inc.; Mediacom Communications Corporation; Cable One, Inc.; Bresnan Communications; Cequel III Communications I, LLC (dba Cebridge Connections); Charter Communications, Inc.; Armstrong Group; Block Communications, Inc.; East Cleveland Cable TV and Communications LLC; Wide Open West Ohio LLC; Massillon Cable TV, Inc.; Mid-Continent Media, Inc.; US Cable Holdings LP; Savage Communications, Inc.; Sjoberg's Cablevision, Inc.; Loretel Cablevision;

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Arvig Communications Systems; Cannon Valley Communications, Inc.; Cable America Corporation; NPG Cable, Inc.; Echostar Satellite LLC; Echostar Technologies Corporation; Ademia Multimedia;, LLC; ACMP, LLC; AEBN, Inc.; Audio Communications, Inc.; Cyber Trend, Inc.; Cybernet Ventures, Inc.; Game Link, Inc.; Global AVS, Inc.; Innovative Ideas International; Lightspeed Media Group, Inc.; National A-1 Advertising, Inc.; New Destiny Internet Group, LLC; VS Media, Inc.; Offendale Commercial Limited BV; and International Web Innovations, Inc.; Time Warner Cable Inc.; CSC Holdings, Inc., and ASKCS.COM, Inc. (collectively, "Defendants").

2. The "Withdrawn Claims" shall mean Claims 19-22, 23, 24, 42-44, 47, 48, 49, 51, 52 and 53 of U.S. Patent No. 5,132,992 ("'992 patent"); Claims 2 and 5 of U.S. Patent No. 5,253,275 ("'275 patent"); Claims 14-16 of U.S. Patent No. 5,550,863 ("'863 patent); and Claims 4 and 6-8 of U.S. Patent No. 6,002,720 ("'720 patent").

3. In exchange for good and valuable consideration, the receipt of which is hereby acknowledged, Acacia hereby covenants not to sue Defendants or their Affiliates (defined below) on the Withdrawn Claims for any past, present, or future claim of infringement arising from manufacturing, having manufactured, exporting, importing, using, selling, or offering to sell any product or method whatsoever, or having engaged in the past in any or all of these activities.

4. Thus, Acacia agrees that, with respect to the Withdrawn Claims, Defendants and their Affiliates shall not be subject to any injunction, and shall have no liability to Acacia or to any purchaser, assignee, or successor-in-interest to the Withdrawn Claims, for any alleged infringement of the Withdrawn Claims, including without limitation any alleged direct infringement, indirect infringement, joint infringement, inducement to infringe, or contributory infringement. For the purpose of this Covenant, **"Affiliate"** shall be defined, with respect to each Defendant, as a separate corporation, company, or other entity which now or hereafter, directly or indirectly through one or more intermediaries, Controls, is Controlled by, or is under common Control with such Defendant. "**Controls**" or "**Controlled by**" and "**under common**

Control with" shall mean the power to direct or cause the direction of the management policies of such corporation, company, or other entity, whether through the ownership of voting securities, or by contract or otherwise.

5. Further, Acacia covenants not to sue any of Defendants' or their Affiliates' subscribers on the Withdrawn Claims, where the alleged infringement results from subscribing to and/or using services offered by Defendants or their Affiliates.

6. This Covenant Not to Sue shall bind Acacia and its parent companies, subsidiaries, affiliates, successors and assigns, and present, former, and future employees, officers, shareholders, directors, representatives, agents, attorneys, successors and assigns, and all other persons acting for or on its behalf. Acacia and Defendants intend this covenant to burden the '992 patent, the '275 patent, the '863 patent, and the '720 patent so as to bar any and all future assignees of the '992 patent, the '275 patent, the '863 patent, and/or the '720 patent from asserting the Withdrawn Claims against Defendants and/or their Affiliates.

7. This Covenant Not to Sue shall not affect Acacia's ability to continue to seek injunctive and/or monetary relief from any Defendant or its Affiliates with respect to any of the remaining patent claims from the patents currently in suit in this action or from any other patents Acacia may assert against any such Defendant or its Affiliates in the future.

8. This Covenant Not to Sue shall not be admissible at trial.

Dated: June 4, 2008

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ORDER

Pursuant to stipulation, it is ordered that:

1. Neither Acacia nor any of its parent companies, subsidiaries, affiliates, successors and assigns, and present, former, and future employees, officers, shareholders, directors, representatives, agents, attorneys, successors and assigns, and all other persons acting for or on its behalf shall sue any Defendant or their Affiliates on claims 19-22, 23, 24, 42-44, 47, 48, 49, 51, 52 and 53 of the ’992 patent; claims 2 and 5 of the ’275 patent; claims 14-16 of the ’863 patent; and claims 4 and 6-8 of the ‘720 patent (hereinafter the “Withdrawn Claims”) for any past, present, or future claim of infringement arising from manufacturing, having manufactured,

exporting, importing, using, selling, or offering to sell any product or method whatsoever, or having engaged in the past in any or all of these activities;

2. Neither Acacia nor any of its parent companies, subsidiaries, affiliates, successors and assigns, and present, former, and future employees, officers, shareholders, directors, representatives, agents, attorneys, successors and assigns, and all other persons acting for or on its behalf shall sue any of Defendants' or their Affiliates' subscribers on the Withdrawn Claims, where the alleged infringement results from subscribing to and/or using services offered by Defendants or their Affiliates;

3. Defendants and their Affiliates shall not be subject to any injunction, and shall have no liability to Acacia or to any purchaser, assignee, or successor-in-interest to the Withdrawn Claims, for any alleged infringement of the Withdrawn Claims, including without limitation any alleged direct infringement, indirect infringement, joint infringement, inducement to infringe, or contributory infringement;

4. Acacia's Covenant Not to Sue shall burden the '992 patent, the '275 patent, the '863 patent, and the '720 patent so as to bar any and all future assignees of the '992 patent, the '275 patent, the '863 patent, and/or the '720 patent from asserting the Withdrawn Claims against Defendants and/or their Affiliates;

5. The Covenant Not to Sue shall not affect Acacia's ability to continue to seek injunctive and/or monetary relief from any Defendant or its Affiliates with respect to any of the remaining patent claims from the patents currently in suit in this action or from any other patents Acacia may assert against any such Defendant or its Affiliates in the future; and

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6. This Covenant Not to Sue shall not be admissible at trial.

DATED: ______________________________________

The Honorable James Ware
United States District Judge